

REMARKS

In the Final Office Action dated October 6, 2003, the Examiner rejects claim 3, the only pending claim, under 35 U.S.C. §103(a) as being unpatentable over Seidenberg, U.S. Patent No. 4,765,396 ("Seidenberg") in view of Kono et al, U.S. Patent No. 5,853,633 ("Kono"). Applicants respectfully traverse the rejection.

The Examiner contends that Seidenberg in view of Kono discloses two of five elements of claim 3. The Examiner further contends that although Seidenberg (and Kono) does not disclose the third element, the range disclosed in Seidenberg is not significantly higher than the upper limit of the claimed range. Then, assuming that the third element is disclosed, the Examiner states that two additional missing elements would be inherently present. Although Applicants readily acknowledge that some logical jumps may be made in the process of verifying that claimed inventions are both new and non-obviousness, it is simply not appropriate to make logical jumps everywhere.

Applicants respectfully assert the Examiner has failed to establish a *prima facie* case of obviousness as required under the law. Furthermore, even if the references were combined, the combination does not teach each and every element of claim 3. Finally, Applicants respectfully assert that the Examiner improperly based an inherency argument upon an untenable combination that does not disclose the elements of claim 3.

Failure to Establish a *Prima Facie* Case of Obviousness

To establish a *prima facie* case of obviousness, the Examiner must show: (1) a suggestion or motivation to combine Seidenberg and Kono, (2) a reasonable expectation of success, and (3) that the references teach or suggest all of the claim limitations. See M.P.E.P. §2142. In this case, however, the Examiner has not established any of these three basic criteria.

1. No Teaching or Suggestion to Combine

The cited references do not include any evidence of a suggestion or motivation to combine the references to arrive at Applicants' invention and the Examiner has not cited any teaching, suggestion, or motivation for combining Seidenberg and Kono. "The factual inquiry

whether to combine references must be thorough and searching”.¹ “It must be based on objective evidence of record”.² “This precedent has been reinforced in myriad decisions, and cannot be dispensed with”.³ Applicant submits that the cited art of record contains no teaching, suggestion, or motivation to combine the references as proposed by the Examiner.⁴ The Examiner is impermissibly picking and choosing the various missing claimed elements using hindsight reasoning in an attempt to recreate the claimed invention with Applicant’s disclosure as the basis. Thus, without using impermissible hindsight reasoning, it would not have been obvious to one of ordinary skill in the art at the time of the invention to modify one or more of the references to include the missing claimed elements as suggested by the Examiner.

Applicants respectfully assert that there could be no motivation to combine the references in part because the cited references are so different from one another and from the present invention. Seidenberg merely discloses a heat pump having an internal wick that is configured for refrigerant fluids. However, Kono does not even mention a wick. Instead, Kono discloses an extruded sheet filter. The Examiner merely selected the Kono reference because it employs a porous high density polyethylene material.

Applicants also respectfully assert that there could be no such suggestion to combine the references in part because the cited references teach away from one another. Seidenberg explicitly discloses a void volume ratio of 40-55%. This void volume ratio is explicitly set forth, and is the only range set forth, because it is the void volume density of POREX UF. See Seidenberg, Col. 5, ll. 55-59. Furthermore, Kono teaches a void volume ratio not less than about 50%. See Kono, Abstract; Col. 1, line 65; and Col. 2, ll. 43-45. Kono teaches that void volume ratios preferably be not less than about 70% and more preferably not less than about 75%. See Col. 2, ll. 32-34. Exemplary embodiments of Kono disclose void volume ratios of about 80%. See Col. 6, ll. 50-53; and Col. 7, ll. 38-40. Kono disparages an example having a void volume

¹ In re Sang Su Lee, 277 F.2d 1338, 1342, 61 U.S.P.Q.2d (BNA) 1430 (Fed. Cir. 2002) (citing McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1351-52, 60 U.S.P.Q.2d (BNA) 1001, 1008 (Fed. Cir. 2001)).

² In re Sang Su Lee at 1342.

³ Id. (citing Brown & Williamson Tobacco Corp. Philip Morris Inc., 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d (BNA) 1456, 1459 (Fed. Cir. 2000) (“a showing of a suggestion, teaching, or motivation to combine the prior art references is an ‘essential component of an obviousness holding’” quoting C.R. Bard, Inc., v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 U.S.P.Q.2d (BNA) 1225, 1232 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994, 999, 50 U.S.P.Q.2d (BNA) 1614, 1617 (Fed. Cir. 1999)).

⁴ See ACS Hosp. Systems, Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577 (Fed. Cir. 1984) (teachings of the prior art can be combined to show obviousness only if there is some suggestion or teaching to do so).

ratio of 40%; Col. 8, ll. 10-25. Thus, with respect to void volume ratios, Kono teaches away from combination with Seidenberg.

2. No Reasonable Expectation of Success

The second requirement of a *prima facie* case of obviousness that the Examiner did not satisfy is that evidence of a reasonable expectation of success must be presented. Moreover, the burden of showing a reasonable expectation of success is on the Examiner, and the Examiner has not specifically addressed this requirement at all.

3. The Combined References Do Not Disclose All Of The Structural Components

The third requirement of a *prima facie* case of obviousness that the Examiner did not satisfy is that all of the claim limitations be taught or suggested in the references cited. Specifically, the Examiner has not shown that all of the claim elements in claim 3 are found in the cited references. For example, none of the references expressly or impliedly describe the element of a void volume ratio of 30-35%.

The Examiner asserts that “the value of 40% disclosed in Seidenberg is not significant higher than the upper limit of the claimed range.” However, both Seidenberg and Kono teach away from a void volume ratio of 30-35% as recited in claim 3. In fact, the combined explicit teachings of Seidenberg and Kono disclose a void volume ratio of 40% to approximately 90%. Furthermore, in light of Kono, the combination teaches that greater than 50% is preferable. Indeed, the combination positively recites two examples where the void volume ratio is 83% and 80.1%, and disparages one ‘comparative example’ having a 40% void volume ratio. The emphasis of Kono on void volume ratios greater than 50% and preferably near 80% clearly creates a hard cut-off at the lower bound of the disclosed 40%- approximately 90% range. Thus, even if the references are combined, the explicit teachings of Seidenberg and Kono do not disclose each element of claim 3, namely 30-35%. In addition, the cited references do not, alone or in any combination, disclose the ‘no leak function’ and the 30-70 mg/hour transfer rate elements of claim 3.

Accordingly, Applicants respectfully submit that the Examiner has thus failed to establish

a *prima facie* case of obviousness, that there is no suggestion or motivation to combine the references, and that the references do not teach or suggest all of the claim elements of claim 3.

Inherency Use Is Improper Here

After combining references that in fact teach away from such a combination, and after concluding that the combination discloses structural elements that in fact are not disclosed, the Examiner claims that the remaining 'performance' element of claim 3 are inherently present in the structure that is disclosed by Seidenberg and Kono. Applicant respectfully disagrees.

Applicants respectfully assert that in light of the lack of teaching or motivation to combine the cited references and because such a combination would still not disclose one of the structural element of claim 3, the application of the inherency doctrine is improper here. In the first place, Applicants assert that inherency can not be asserted based off a tenuous combination of references. This double step is far too vague and ill defined. The combination of two references to create a §103 rejection necessarily means that the Examiner can not find that invention in a single reference and so must create a fictional thing. It is improper to then build upon this unsteady foundation to state that based on this fictional thing, some further as yet undisclosed element must necessarily exist.

In the second place, inherently present elements must be found to necessarily exist from elements that are disclosed in the prior art. As set forth above, the recited references do not disclose a void volume ratio of 30-35%, but rather discloses only ratios greater than 40%. As such, inherency, if applicable, would only apply to those features inherent in the physical structure contemplated by the combination. As noted above, the combination is not only improper, but also is not the same as the structure recited in claim 3.

Finally, the case law is clear that in a proper application of inherency, the Examiner must prove that the undisclosed performance factors must necessarily be present, and that it would be so recognized by persons of ordinary skill in the art. In re Best, 562 F.2d 1252, 1255 U.S.C.C.A.P.A. 1977; and Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1269 (Fed. Cir. 1991). It is not enough to assert that the undisclosed performance factors might, sometimes, result from the disclosed structural elements. Scaltech, Inc. v. RETEC/TETRA, L.L.C., 178 F.3d

1378 (Fed. Cir. 1999). "Inherency may not be established by probabilities or possibilities." Id. Furthermore, the Examiner is required to prove that the presence of the undisclosed elements was known by those skilled in the art. Rosco, Inc. v. Mirror Lite Co., 304 F.3d 1373, 1380-1381, (Fed. Cir. 2002). Applicants assert that this level of proof is difficult to attain because the references, alone or in combination, do not disclose all of the structural elements of claim 3.

Thus, because there is no teaching or suggestion to combine the cited references, because the combined references do not disclose all of the structural elements of claim 3, and because the Examiner has presented no evidence that the undisclosed elements are necessarily present, Applicants respectfully request that the inherency argument be withdrawn.

CONCLUSION

Therefore, the cited references do not disclose each and every element of claim 3. Accordingly, Applicants respectfully request allowance of the pending claim. The Examiner is invited to telephone the undersigned at (602) 382-6337 at the Examiner's convenience, if that would help further prosecution of the subject Application. Applicants authorize and respectfully request that any fees due be charged to Deposit Account No. 19-2814. **This statement does NOT authorize charge of the issue fee.**

Respectfully submitted,

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